

### **REMARKS/ARGUMENTS**

These remarks are made in response to the Office Action of January 21, 2009 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due. However, the Examiner is expressly authorized to charge any deficiencies to Deposit Account No. 14-1437.

#### **Claim Rejections – 35 USC § 103**

In the Office Action, Claims 1-4, 8, 10, 26-32, and 34-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,691,162 to Wick (hereinafter Wick) in view of U.S. Patent 7,266,776 to Quillen, *et al.* (hereinafter Quillen). Claims 5 and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wick in view Quillen, and in further view of U.S. Patent 6,430,604 to Ogle, *et al.* (hereinafter Ogle).

Applicants respectfully disagree with the rejections and thus have not amended the claims to overcome the rejections. Also, Applicants have submitted new Claims 38-45. The new claims are fully supported by the original disclosure and no new matter has been introduced.

#### **Aspects of Applicants' Invention**

It may be helpful to reiterate certain aspects of Applicants' invention prior to addressing the cited references. One embodiment of the invention, as illustrated by Claim 1, is an instant messaging method.

The method can include displaying a user selectable list of subscribers in a graphical user interface of an instant messaging service. The method can also include selecting a group of subscribers in an inactive state from the list in the graphical user interface. Furthermore, the method can include designating at least one action associated with the group via the graphical user interface, the at least one designated action to be automatically performed with respect to each subscriber in the group in response to a

state change; automatically detecting a state change of at least one of the subscribers in the group; and, automatically executing the designated action associated with the group for the at least one subscriber responsive to the detecting step. (See, e.g., Specification, paragraphs [0038]-[0039], and FIGS. 1-2)

**The Claims Define Over The Prior Art**

It was stated in the Office Action that Wick does not teach selecting a group of subscribers within a list, designating at least one action with the group, the at least one designated action to be automatically performed with respect to each subscriber in the group in response to a state change, automatically executing the designated action associated with the group for the at least one subscriber responsive to the detecting step.

However, it was asserted in the Office Action that Quillen teaches selecting a group of subscribers within a list (column 10, lines 35-40 and column 12, lines 36-50), designating at least one action with the group (column 10, lines 35-40 and column 12, lines 36-50), the at least one designated action to be automatically performed with respect to each subscriber in the group in response to a state change (column 10, lines 35-40 and column 12, lines 36-50), automatically executing the designated action associated with the group for the at least one subscriber responsive to the detecting step (column 10, lines 35-40 and column 12, lines 36-50).

Column 10, lines 35-40 and column 12, lines 36-50 of Quillen read as follows:

*Likewise, other operations may be performed on icon 520 to execute corresponding actions related to the contact represented by icon 520. For instance, right-clicking on icon 520 may bring up a context menu that has an option to set an alert when the contact comes online. Selecting the option results in the alert being set for the contact or set of contacts. Or, double-clicking on the icon may bring up profile information about the contact that icon 520 represents.*

*A user can perform operations on any of the icons 820, 825, or 830 to cause actions to be executed for the contact represented by the respective icon, as described above. For instance, the program user can drop a binary*

*file onto icon 820 to transfer the file to randomcontact. The program user can drop a text file (or paste text) on icon 825 to, depending upon a specified configuration, initiate a group chat session with the set of contacts grouped as "co-workers" or to invoke independent chat sessions with each contact in the "co-workers" group. The program user also, for instance, may set an alert for when randomcontact2 comes online by selecting icon 830 to bring up a context menu and selecting an alert option from the menu. In addition, icons 820, 825, and 830 may indicate the online presence, or other contextual information, of the respective contact it represents, also as described above.*

The above paragraphs describe that certain operations can be performed on the icons. However, it is noted that Quillen does not disclose selecting a group of inactive subscribers in an inactive state from the list of subscribers in the graphical user interface. The contact or set of contacts represented by the icons in Quillen is not selected based on an inactive state of the subscribers.

Quillen also does not disclose that the at least one designated action is to be automatically performed with respect to each subscriber in the group in response to a state change. In Quillen the operations are performed by the user, not automatically by the system upon detection of a state change.

Quillen further does not disclose automatically detecting a state change of at least one of the subscribers in the group; and automatically executing the designated action associated with the group for the at least one subscriber responsive to the detecting step. In Quillen the actions are caused by operations performed by the user on the icons, not caused by a detection of state change of subscribers in the group.

Therefore, a combination of Wick and Quillen does not disclose an important aspect of the present invention, namely automatically executing a designated action to a group of inactive subscribers when a state change is detected for the group of inactive subscribers. In Wick, an action can only be designed and executed to each individual subscriber or targeted user, not a group of subscribers or targeted users, upon the

detection of a state change. Quillen does not make up for the deficiencies of Wick because in Quillen the group is not at all formed based on an inactive state and actions are not executed based upon a detection of a state change.

Accordingly, the cited references, alone or in combination, fail to disclose or suggest each and every element of Claims 1, 38, and 45. Applicants therefore respectfully submit that Claims 1, 38, and 45 define over the prior art. Furthermore, as each of the remaining claims depends from Claims 1 or 38 while reciting additional features, Applicants further respectfully submit that the remaining claims likewise define over the prior art.

Applicants thus respectfully request that the claim rejections under 35 U.S.C. § 103 be withdrawn.

### **CONCLUSION**

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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